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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,068	09/07/2000	Kenneth M. Buckland	062891.0362	1585
5073	7590	06/15/2011		
BAKER BOTTS L.L.P.			EXAMINER	
2001 ROSS AVENUE			WILSON, ROBERT W	
SUITE 600				
DALLAS, TX 75201-2980			ART UNIT	PAPER NUMBER
			2475	
			NOTIFICATION DATE	DELIVERY MODE
			06/15/2011	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH M. BUCKLAND

Appeal 2009-007845
Application 09/657,068¹
Technology Center 2400

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

Concurring-In-Part Opinion filed by BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Cisco Technology, Inc.

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 1, 3-7, 9-16, 18-33, 35-38, and 40.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's invention concerns a system and method for processing traffic in an access network. Incoming Internet Protocol (IP) traffic is converted to asynchronous transport mode (ATM) cells for efficient switching within the access network (or within a single access unit) and converted back to IP packets at the edge of the access network. The ingress traffic streams are aggregated into a single combined traffic stream regardless of final destination (Spec. 3).

Claim 1 is exemplary of the claims on appeal:

1. A method for processing traffic in an access network, comprising;
receiving a plurality of ingress traffic streams, each ingress traffic stream including a plurality of packets having a destination address, wherein the packets are Internet Protocol (IP) packets and each include an IP destination address;
aggregating the ingress traffic streams into a single combined traffic stream without regard to any destination of any packet from any ingress traffic stream;
and transmitting the combined traffic stream to a backbone network for routing.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Kshirsagar	US 6,016,319	Jan. 18, 2000
Keller-Tuberg	US 6,504,844 B1	Jan. 7, 2003

² Claims 2, 8, 17, 34, and 39 have been cancelled.

Claims 1, 3-7, 9-16, 18-33, 35-38, and 40 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 3-7, 9-16, 18-33, 35-38, and 40 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 20-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as his invention.

Claims 1, 3-7, 9-16, 18, and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Keller-Tuberg.

Claims 20-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keller-Tuberg in view of Kshirsagar.

Claims 26-33, 35-38, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keller-Tuberg.

Throughout this decision, we make reference to the Appeal Brief (“App. Br.,” filed Apr. 29, 2008), the Reply Brief (“Reply Br.,” filed Sep. 2, 2008), and the Examiner’s Answer (“Ans.,” mailed July 2, 2008) for their respective details.

ISSUE

Appellant argues, *inter alia*, that Keller-Tuberg discloses multiplexing traffic from a large number of subscribers into a smaller number of ATM flows, but does not disclose aggregating traffic streams into a single combined traffic stream, as the claims require (App. Br. 9).

Appellant's contentions present us with the following issue:
Does Keller-Tuberg teach or fairly suggest aggregating the ingress traffic streams into a single combined traffic stream?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Keller-Tuberg

1. Keller-Tuberg teaches that at the service provider interface, traffic arrives from a large number of subscribers multiplexed into a much smaller number of ATM flows (col. 2, ll. 43-45).

PRINCIPLES OF LAW

Section 103(a) forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 405 (2007).

Absent a showing of good cause, the Board is not required to address an argument first presented in the Reply Brief that could have been, but was not, presented in the principal Brief. *See Ex parte Borden*, 93 USPQ2d 1473, 1473-74 (BPAI 2010) ("informative"³).

³ The "informative" status of this opinion is noted at the following Board website: <http://www.uspto.gov/ip/boards/bpat/decisions/inform/index.jsp>.

ANALYSIS

§ 112 Rejections

The Examiner, in the Answer, rejected all pending claims under § 112, first paragraph as failing to comply with both the enablement requirement and the written description requirement, and rejects claims 20-25 under § 112, second paragraph (Ans. 3-5). These rejections are a repetition of the § 112 rejections made in the Final Rejection mailed July 26, 2007 (Final Rej. 2-3). Appellant's Request for Pre-Appeal Brief Review filed January 7, 2008 presented argument with respect to the § 112 rejections, making it clear that Appellant was aware that these rejections were outstanding in the application.

Appellant's Brief presented no arguments with respect to any of the three § 112 rejections, however, and did not even list the rejections in the "GROUND OF REJECTION TO BE REVIEWED ON APPEAL" (App. Br. 8). Appellant's single-paragraph discussion of these rejections in the Reply Brief is not entitled to consideration absent a showing of good cause. *See Ex parte Borden*, 93 USPQ2d at 1473-74.

Because Appellant did not present argument, we find that the Examiner did not err in rejecting claims 1, 3-7, 9-16, 18-33, 35-38, and 40 under § 112, first paragraph, as failing to comply with the written description requirement and the enablement requirement. We further find that the Examiner did not err in rejecting claims 20-25 as being indefinite under § 112, second paragraph. We will sustain each of the § 112 rejections.

§ 102 AND § 103 REJECTIONS

The appealed independent claims require "a single combined traffic stream" (claim 1) or "*the* combined traffic stream" (claim 26, emphasis

added). Keller-Tuberg teaches that at the service provider interface, traffic arrives from a large number of subscribers multiplexed into a much smaller number of ATM *flows* (FF 1, emphasis added). Keller-Tuberg teaches “flows,” plural, but does not teach a single, i.e., *one*, combined traffic stream, as the claims require.

Further, it is not clear from Keller-Tuberg whether traffic from a particular subset of subscribers is specifically multiplexed into a single ATM flow, or whether traffic from all subscribers is comingled and multiplexed into plural ATM flows without any attempt to assign particular subscribers to a particular flow. Thus, even construing the claim term “comprising” broadly, so as to read on a traffic flow having multiple combined traffic streams in which some of the ingress traffic streams flow into a particular one of the combined traffic streams, we cannot identify disclosure in Keller-Tuberg that teaches “aggregating the ingress traffic streams into a single combined traffic stream,” as claimed.

Therefore, we agree with Appellant that Keller-Tuberg does not teach aggregating a plurality of ingress traffic streams into a single combined traffic stream. Because Keller-Tuberg does not teach all the limitations of the independent claims, we will not sustain the § 102 rejection of claims 1, 3-7, 9-16, 18, and 19 as being anticipated by Keller-Tuberg.

We will not sustain the § 103 rejection of claims 20-25 for the same reasons. We have reviewed Kshirsagar and found that it does not overcome the deficiencies of Keller-Tuberg.

As independent claim 26 contains the same critical limitation as claims 1 and 16, we will not sustain the § 103 rejection of claims 26-33, 35-38, and 40 for the reasons noted *supra* with respect to claim 1.

CONCLUSION

Keller-Tuberg does not teach or fairly suggest aggregating the ingress traffic streams into a single combined traffic stream.

ORDER

The Examiner's rejection of claims 1, 3-7, 9-16, 18-33, 35-38, and 40 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

BAUMEISTER, *Administrative Patent Judge*, CONCURRING-IN-PART:

I concur with the Majority’s decision reversing all of the prior art based rejections of claims 1, 3-7, 9-16, 18-33, 35-38, and 40. I respectfully dissent from the Majority’s decision to summarily affirm the rejections of claims 1, 3-7, 9-16, 18-33, 35-38, and 40 under either the first or second paragraph of 35 U.S.C. § 112. I would instead find that the rejections under § 112, ¶¶ 1, 2 are not properly before us on appeal, and I would therefore not reach any decision regarding these rejections.

The Majority is correct in noting (Majority Op. 5) that the prosecution history provided Appellant with adequate notice that the Examiner had not dropped at least some of the § 112 rejections. *See* After Final Amendment 12-13, filed Sep. 26, 2007 (asserting that the proposed claim amendments resolve the § 112, ¶¶ 1, 2 rejections); *cf.* Advisory Action mailed Dec. 5, 2007 (indicating that the proposed after-final claim amendments were entered into the record, failing to address the 112-2nd rejection, but stating that “[t]he examiner respectfully disagrees with the applicant’s argument that the 112/1st paragraph rejection⁴ has been traverse”). If this were the only issue, I would agree with the Majority that Appellant’s failure to present any timely arguments in the Appeal Brief would justify a summary affirmation of the § 112, ¶¶ 1, 2 rejections.

⁴ The recitation of “the 112/1st paragraph rejection” (in the singular) renders it unclear whether the Examiner was intending to maintain just the enablement rejection or both the enablement and written description rejections under § 112, ¶ 1.

However, the Examiner subsequently rendered the record unreasonably ambiguous. In response to Appellant's assertion that the art-based rejections were the only basis of the appeal (App. Br. 8 (section labeled GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL)), the Examiner expressly agreed that "The appellant's statement of the grounds of rejection to be reviewed on appeal is correct" (Ans. 3, (SECTION (6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL)). Furthermore, the Examiner failed to otherwise comment in the RESPONSE TO ARGUMENTS section of the Examiner's Answer that Appellant was mistaken in alleging that the art based rejections were the only rejections on appeal (*see* Ans. 13 (setting forth an unnumbered section labeled "Appellant's Argument," presumably intended to constitute the Answer's RESPONSE TO ARGUMENTS section)).

Granted, the Examiner did set forth the § 112, ¶¶ 1, 2 rejections in the Answer's GROUNDS OF REJECTION section (Ans. 3-5). However, this fact only begs the question of whether the section § 112, ¶¶ 1, 2 rejections were being maintained, it does not resolve it. That is, section six of the Answer (the GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL section) indicates that the § 112, ¶¶ 1, 2 rejections are *not* a part of the appeal; section nine of the Answer (the GROUNDS OF REJECTION section) indicates that these rejections *are* a part of the appeal; and the portion of the Answer presumed to be section ten (the RESPONSE TO ARGUMENTS section) is silent. On the whole, then, the Examiner's Answer is ambiguous because section six directly contradicts section nine. The statements respectively set forth in these two sections cannot both be correct.

It may well be the case that the GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL section contains the erroneous statement: it is quite foreseeable that the Examiner accidentally included the wrong form paragraph. It is equally possible that the Examiner was never properly trained on the fact that the GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL section is specifically included in the Examiner's Answer for a reason: to serve as a confirmation for the appeals panels that both parties agree as to the scope of issues on appeal, and thereby ensure that appeals panels are not faced with the exact ambiguity that is currently before ours.

However, any conclusion that the GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL section is the one that contains the error is merely the product of speculation. It is equally foreseeable that (1) the Examiner and Appellant discussed the § 112 rejections in a telephone interview that was never entered into the record, or (2) the Examiner decided to drop the § 112 rejections as a result of the appeal conference. In either case, the statement in the GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL section would have been accurate, and the inclusion of the § 112 rejections in Answer's subsequent GROUNDS OF REJECTION section may well have been the result of mistakenly cutting-and-pasting unintended portions of the final rejection into the Answer.

My conclusion that the present panel should not address the § 112 rejections is not intended to be punitive in any manner. I fully appreciate how busy Examiners are, as are the plural managers who review and sign an Examiner's Answer. I recognize that no one is perfect and that mistakes happen.

My conclusion is instead based upon a law-and-economics approach in which the burden of correcting a mistake is allocated to the party that can properly correct the mistake most efficiently. With respect to the present mistake, the Examiner is in a significantly better position to properly address the ambiguity than is the present appeals panel. The Majority is merely speculating that the Examiner intended to maintain the § 112, ¶¶ 1, 2 rejections. The Examiner, on the other hand, knows with certainty whether he intended to maintain the § 112 rejections.

Because of the attendant ambiguities, I would not conclude that the rejections under § 112, ¶¶ 1, 2 are being appealed. As such, I would not further decide whether these presumed rejections are proper. If the Examiner did, in fact, intend to defend these rejections on appeal, the Examiner could re-assert these rejections subsequent to our reaching a decision on the art based rejections. As it stands now, though, the Majority has found the claims to be indefinite, non-enabled, and lacking adequate written description regardless of whether the Examiner may still hold these views.